

INDEX

	Page
Opinions below	-
Jurisdiction	1
Question presented	2
Statutes and regulations involved	2
Statement	2
Summary of argument	4
Argument	6
The District Court Had Jurisdiction To Review The Rul- ing Of The Patent Office	6
A. The Statutory Language	9
B. Legislative History	12
C. Judicial Practice	27
D. The Nature of the Patent Office Ruling in this Case	34
Conclusion	38
Appendix A: Statutes and Regulations	40
Appendix B: Number of Suits under R. S. 4911 and 4915	66
Appendix C: Letter from Commissioner of Patents re practice in Patent Office	67

CITATIONS

Cases:

<i>Abercrombie v. Coe</i> , 119 F. (2d) 458	30
<i>American Cable Co. v. John A. Roebling's Sons Co.</i> , 65 F. (2d) 801	33, 35
<i>American Cyanamid Co. v. Coe</i> , 106 F. (2d) 851	28
<i>American Steel and Wire Co. v. Coe</i> , 105 F. (2d) 17	30
<i>Booth Fisheries Corp. v. Coe</i> , 114 F. (2d) 462, certiorari denied, 311 U. S. 691	28
<i>Butterworth v. Hill</i> , 114 U. S. 128	13
<i>Butterworth v. Hoe</i> , 112 U. S. 50	11, 32, 35
<i>Carlin v. Goldberg</i> , 45 App. D. C. 540	33
<i>Chesin v. Robertson</i> , 63 F. (2d) 267, certiorari denied, 289 U. S. 725	32, 33
<i>Cherry-Burrell Corp. v. Coe</i> , 143 F. (2d) 372	32
<i>Cleveland Trust Co. v. Berry</i> , 99 F. (2d) 517	11, 26, 35
<i>Cleveland Trust Co. v. Nelson</i> , 51 F. (2d) 276	11, 35
<i>Coe v. United States ex rel. Remington Rand Inc.</i> , 84 F. (2d) 240	34
<i>Colgate-Palmolive Peet Co. v. Coe</i> , 144 F. (2d) 517	8
<i>Cooper v. Robertson</i> , 38 F. (2d) 852	13

II

Cases—Continued.

	Page
<i>Cregier v. Coe</i> , 67 F. (2d) 692, certiorari denied, 291 U. S. 683.....	33
<i>Dily v. Moore</i> , 34 App. D. C. 106.....	14, 26, 27
<i>E. I. Du Pont De Nemours & Co. v. Coe</i> , 89 F. (2d) 879.....	27
<i>Fekete v. Robertson</i> , 17 F. (2d) 335.....	13
<i>Forward Process Co. v. Coe</i> , 116 F. (2d) 946.....	27
<i>Frasch v. Moore</i> , 211 U. S. 1.....	35
<i>Gandy v. Marble</i> , 122 U. S. 432.....	11, 26, 35
<i>General Motors Corp. v. Coe</i> , 120 F. (2d) 736.....	30
<i>Gold v. Newton</i> , 254 Fed. 824.....	15, 30
<i>Hill v. Wooster</i> , 132 U. S. 693.....	31, 35
<i>Hydraulic Press Corp. v. Coe</i> , 124 F. (2d) 521.....	30
<i>In Re Mavrogenia</i> , 57 F. (2d) 361.....	33
<i>In Re Briede</i> , 27 App. D. C. 298.....	10
<i>In Re Slate</i> , 108 F. (2d) 268.....	33
<i>In Re Stern</i> , 40 F. (2d) 1000.....	33
<i>International Cellucotton Products Co. v. Coe</i> , 85 F. (2d) 869.....	28
<i>Kirk v. Commissioner of Patents</i> (1886) C. D. 440 (Sup. Ct. D. C.).....	13, 20
<i>Line Material Co. v. Coe</i> , 144 F. (2d) 518.....	8
<i>Minnesota Mining & Manufacturing Co. v. Coe</i> , 125 F. (2d) 198.....	30
<i>Minnesota Mining & Manufacturing Co. v. Coe</i> , 143 F. (2d) 12.....	34
<i>Minnesota Mining & Manufacturing Co. v. Coe</i> , 145 F. (2d) 25, certiorari denied, January 15, 1945.....	8
<i>Monopower Corp. v. Coe</i> , 33 F. Supp. 934.....	27
<i>Monsanto Chemical Co. v. Coe</i> , 145 F. (2d) 18.....	8
<i>Morgan v. Daniels</i> , 153 U. S. 120.....	35
<i>Philadelphia Storage Battery Co. v. Zenith Radio Corp.</i> , 117 F. (2d) 642.....	12
<i>Pitman v. Coe</i> , 68 F. (2d) 412.....	29, 33
<i>Postum Cereal Co. v. Calif. Fig. Nut Co.</i> , 272 U. S. 693.....	35
<i>Potter v. Dixon</i> , 19 Fed. Cas. 1145.....	15, 30
<i>Poulsen v. McDowell</i> , 142 F. (2d) 267.....	30
<i>Power Patents Co. v. Coe</i> , 110 F. (2d) 550.....	27
<i>Radtke Patents Corp. v. Coe</i> , 122 F. (2d) 937, certiorari denied, sub nom. <i>American Tri-Ergon Corp. v. Radtke Patents Corp.</i> , 314 U. S. 695.....	30, 31
<i>Shoemaker v. Robertson</i> , 54 F. (2d) 456.....	32
<i>Sinko Tool & Manufacturing Co. v. Automatic Devices Corp.</i> , 136 F. (2d) 186.....	25
<i>Spatofora v. Zaifer</i> , 69 F. (2d) 118.....	33
<i>Steinmetz v. Allen</i> , 192 U. S. 543.....	34
<i>Svenson v. Coe</i> , 101 F. (2d) 684.....	34
<i>Synthetic Plastics Co. v. Ellis-Foster Co.</i> , 78 F. (2d) 847.....	33, 35
<i>Tully v. Robertson</i> , 19 F. (2d) 954.....	27

III

Cases—Continued.

	Page
<i>United States ex rel. American Gas-Accumulator Co. v. Coe</i> , 84 F. (2d) 398.....	34
<i>Victor Talking Machine Co. v. Brunswick-Balke-Collender Co.</i> , 273 U. S. 670.....	35
<i>Westinghouse Electric & Mfg. Co. v. De Forest Radio, Telephone & Telegraph Co.</i> , 278 U. S. 562.....	35
<i>Youngstown Sheet and Tube Co. v. Coe</i> , Civ. Act. 5460, decided April 8, 1941.....	29

Statutes:

Act of April 10, 1790, 1 Stat. 109.....	16
Act of February 21, 1793, 1 Stat. 318.....	16
Act of July 4, 1836 (5 Stat. 117 <i>et seq.</i>):	
§ 7.....	16, 40
§ 16.....	17, 36, 42
Act of March 3, 1837 (5 Stat. 491 <i>et seq.</i>) § 8.....	17, 43
Act of March 3, 1839 (5 Stat. 353 <i>et seq.</i>):	
§ 10.....	18, 44
§ 11.....	18, 44
Act of August 30, 1852 (10 Stat. 75).....	18, 46
Act of March 3, 1863 (12 Stat. 762).....	18
Act of July 8, 1870 (16 Stat. 198).....	18
§ 46.....	46
§ 47.....	47
§ 48.....	21, 47
§ 49.....	21, 47
§ 50.....	21, 47
§ 51.....	21
§ 52.....	19, 10, 47
Act of February 9, 1893 (27 Stat. 434 <i>et seq.</i>).....	22
§ 9.....	49
Act of March 2, 1927 (44 Stat. 1335 <i>et seq.</i>).....	23
§ 7.....	50
§ 8.....	50
§ 9.....	51
§ 11.....	51
Act of March 2, 1929 (45 Stat. 1475 <i>et seq.</i>).....	25
§ 2 (a).....	52
§ 2 (b).....	53
§ 2 (d).....	53
Act of August 5, 1939 (53 Stat. 1212 <i>et seq.</i>).....	25
§ 2.....	54
§ 3.....	54
§ 4.....	54
Revised Statutes of 1873:	
§ 4911.....	48
§ 4915.....	48
Revised Statutes (35 U. S. C., Secs. 52 <i>et seq.</i>):	
§ 4904.....	38, 55
§ 4909.....	10, 37, 55

IV.

Statutes—Continued.

Revised Statutes—Continued.

Page

§ 4911.....	5, 9, 11, 13, 21, 37, 55
§ 4912.....	8, 21, 56
§ 4914.....	10, 21, 56
§ 4915.....	4, 6, 9, 10, 11, 13, 20, 56
§ 4916.....	10, 57

Regulations:

Rules of Practice in the United States Patent Office (Reprint September 1, 1943):

Rule 76.....	11, 59
Rule 93.....	38, 59
Rule 94.....	3, 38, 60
Rule 109.....	28, 62
Rule 149.....	8, 63
Rule 164.....	11, 64
Rule 167.....	11, 65

Miscellaneous:

2 Cong. Rec. 646, 647-648, 829, 849-858, 995-1001, 1027, 1031, 1206, 1215, 1249-1254, 1414-1417, 1460-1462, 1611-1620, 1657-1662, 1789-1795, 1819-1825, 1868 & 1876, 2005-2013, 2251-2255, 2709-2714, 4285.....	22
22 Journ. Pat. Off. Soc., pp. 269-270, etc.....	16
Cong. Globe (41st Cong., 2d Sess.) pp. 2679-2683, 4820.....	19
Federico, <i>Evolution of Patent Office Appeals</i> (1940) Journ. Pat. Off. Soc. 920, 940-941.....	22
H. R. 1714 (41st Cong., 2d Sess.).....	19
H. R. 1215 (43d Cong., 1st Sess.).....	21
H. R. 7087 (69th Cong., 1st Sess.).....	23
H. Rep. 1889 (69th Cong., 2d Sess.) pp. 2-3.....	24
Hearings, House Committee on Patents, on H. R. 6252 & H. R. 7087 (69th Cong., 1st Sess.).....	14, 23, 24, 25
Hearings, House Committee on Patents, on H. R. 7563 & H. R. 13487 (69th Cong., 2d Sess.).....	23, 25
Hearings, Senate Committee on Patents, on S. 4812 (69th Cong., 2d Sess.).....	23, 24, 25
Hearings, House Committee on the Judiciary, on H. R. 6687 (70th Cong., 1st Sess.).....	25
Lutz, <i>Evolution of the Claims of the United States Patents</i> , 20 Journ. Pat. Off. Soc., 457, 469.....	37
Report of Committee on Patent Office Procedure submitted to the Secretary of Commerce, April 15, 1926.....	23
Report of the Investigation of the United States Patent Office made by the President's Commission on Economy and Efficiency, December 1912, H. Doc. 1110 (62d Cong., 3d Sess.) pp. 207-208.....	15
Sen. Doc. 338 (24th Cong., 1st Sess.) p. 2.....	16
S. Rep. 1313 (69th Cong., 2d Sess.) p. 4.....	24
Walker, <i>Patents</i> (Deller's Ed., 1937) p. 1366.....	38

In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 486

THE HOOVER COMPANY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT
OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT

OPINIONS BELOW

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 140-146) is reported at 144 F. (2d) 514.

JURISDICTION

The judgment of the District Court was entered on June 21, 1943 (R. 14). The judgment of the Court of Appeals was entered on July 10, 1944 (R. 147). The petition for a writ of certiorari was filed on September 20, 1944, and granted on

November 6, 1944. The jurisdiction of this Court rests upon Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the United States District Court for the District of Columbia has jurisdiction under Rev. Stat. 4915 (35 U. S. C. 63) over a suit by an applicant for reissue of a patent to compel the Commissioner of Patents to allow certain claims which had been rejected by the United States Patent Office as unpatentable to that applicant; where further proceedings in the Patent Office to determine priority of invention would be required if the court disagreed with the Patent Office as to the rejection.

STATUTES AND REGULATIONS INVOLVED

The relevant portions of the statutes and regulations involved are set forth in Appendix A, pp. 40-65, *infra*.

STATEMENT

On an application filed August 8, 1936 (R. 88-112), United States Patent No. 2,178,870 was granted to C. C. Coons, petitioner's assignor, on November 7, 1939, covering improvements in a refrigerating system (R. 3-4, 8). On January 10, 1941, Coons applied to the Patent Office for reissuance of the patent, presenting a number of claims copied or substantially copied from several later patents in order to provoke "interferences" there-

with and a contest as to priority (R. 4-6, 8, 113-115).¹ On March 28, 1941, the Primary Examiner in the Patent Office allowed sixteen of the claims as "patentable" and "readable" upon the original Coons application, and declared the reissue application to be in interference with two of the later patents from which the sixteen claims had been taken (Ullstrand No. 2,215,674, and Anderson No. 2,203,074; R. 113-115). However, the Primary Examiner rejected "as not reading on applicant's disclosure" eight claims taken from the Bergholm patent No. 2,201,362, which had been granted May 21, 1940 (R. 117-128) on an application filed November 20, 1937 (R. 137).

Four of these rejected claims were appealed to the Board of Appeals of the Patent Office, which affirmed the Primary Examiner (R. 129-133). Thereafter, petitioner, as Coons' assignee, brought suit against the Commissioner of Patents under Section 4915 of the Revised Statutes (35 U. S. C. 63) in the United States District Court for the District of Columbia, to compel the Commissioner to allow the four appealed claims for purposes of an interference proceed-

¹ Rule 94 of the Patent Office provides in part:

"94. * * * interferences will * * * be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: * * *." See Appendix A, *infra*, pp. 60-62.

ing with the Bergholm patent (R. 3-7). After receiving in evidence the record before the Patent Office and additional evidence on behalf of petitioner (R. 24-82), the District Court entered findings of fact and conclusions of law, and on June 21, 1943, dismissed the complaint on the ground that the appealed claims were not "readable on" (*i. e.*, did not accurately describe) the disclosure in the Coons application (R. 10-14).

On appeal, the Court of Appeals, on its own motion, raised the question "whether Section 4915 R. S. confers jurisdiction on the District Court to enter a decree which does not determine the right of the applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings" (R. 141). Following the submission of memoranda by both parties in support of the jurisdiction of the District Court (R. 141), the court below held that the District Court lacked jurisdiction over the suit and affirmed the judgment dismissing the complaint (R. 147).

SUMMARY OF ARGUMENT

Rev. Stat. 4915 provides that upon a refusal of a patent a bill in equity may be filed and the court "may adjudge that such applicant is entitled, according to law, to receive a patent for his invention * * *. And such adjudication, if it be in favor of the right of the applicant,

shall authorize the commissioner to issue such patent on the applicant * * * otherwise complying with the requirements of law." This language literally can be construed either as meaning that the court may adjudge only that an applicant is finally entitled to a patent without further proceedings in the Patent Office apart from complying with formal conditions, or that the court may authorize the Commissioner of Patents to issue the patent when the applicant has fully satisfied all other legal requirements. In our view the latter interpretation rather than the one adopted below is correct.

This is indicated by the legislative history of the provision. When the section was revised in other respects in 1927 the attention of Congress was called to a decision in which a court had taken jurisdiction under circumstances comparable to those at bar. And it appears definitely that Congress intended Rev. Stat. 4915 to be coextensive with Rev. Stat. 4911, which provides for review in the Court of Customs and Patent Appeals, so that an applicant could have alternative remedies but not both. The court below conceded that the present case could have been brought under Rev. Stat. 4911. Furthermore, prior to the present case, the Court of Appeals and other courts had without question frequently taken jurisdiction of cases in which further proceed-

ings in the Patent Office would be necessary if the decision of the Patent Office was reversed, so that the unchallenged practice can be said to represent an understanding of the law on the part of the bar and of the courts.

The order of the Patent Office in this case was not interlocutory; it finally disposed of the applicant's claims in issue. It is analogous to the granting of a motion to dismiss a suit in court, which is a final, appealable order. The fact that further proceedings may be necessary on reversal would not seem to justify a refusal to take jurisdiction any more in the one situation than the other.

ARGUMENT

THE DISTRICT COURT HAD JURISDICTION TO REVIEW THE RULING OF THE PATENT OFFICE

Section 4915 of the Revised Statutes, which petitioner invoked as the basis of the District Court's jurisdiction, provides in part:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such

refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant; whether the final decision is in his favor or not. * * *

The court below held that the jurisdiction of the District Court under Rev. Stat. 4915 is limited to situations in which, if the court disagrees with the Patent Office action, a decree can be entered directing that a patent issue to the applicant without further proceedings in the Patent Office. The court concluded that such a decree could not be made in the instant case since a reversal of the Patent Office would not entitle petitioner to receive a patent for the claims in issue until priority over Bergholm was determined in the ensuing interference proceedings before the Patent Office—an issue not determinable upon the record before the

court (R. 142). Despite somewhat broader statements in the court's opinion (see R. 142), other decisions rendered by the court on the same day² indicate that it intended to hold Rev. Stat. 4915 inapplicable only where the record affirmatively shows that further proceedings in the Patent Office will be necessary following an adjudication favorable to the applicant. In such a situation the remedy of the applicant, according to the court below, is by an appeal to the United States Court of Customs and Patent Appeals under Rev. Stat. 4911 (R. 146).³

The precise question presented here has apparently never before been raised or decided. While the ruling below finds some support in the statutory language, it is inconsistent with the legislative materials and with the unchallenged acceptance of jurisdiction by the Federal courts for many years in situations identical with or similar to that presented at bar. And, whatever considerations of policy may be adduced in support

² *Line Material Co. v. Coe*, 144 F. (2d) 518 (App. D. C.); *Colgate-Palmolive Peet Co. v. Coe*, 144 F. (2d) 517 (App. D. C.). See also *Monsanto Chemical Co. v. Coe*, 145 F. (2d) 18 (App. D. C.), footnote 2. Cf. *Minnesota Mining & Manufacturing Co. v. Coe*, 145 F. (2d) 25 (App. D. C.), footnote 2, certiorari denied, January 15, 1945.

³ In this case, petitioner's right to this alternative remedy may be doubtful, since petitioner's time for appeal to the United States Court of Customs and Patent Appeals expired before the present suit was instituted. Rev. Stat. 4912; Rule 149, Rules of the Patent Office (R. 131-133). See Appendix A, *infra*, pp. 56, 63-64.

of the jurisdictional line drawn below between District Court and Court of Customs and Patent Appeals, they are matters for Congressional rather than judicial consideration, since the present statutory scheme seems to contemplate substantially coextensive jurisdiction in each court.

A. THE STATUTORY LANGUAGE

For its conclusion that Rev. Stat. 4915 does not apply here, the court below relied upon the provision therein that the court "may adjudge that such applicant is entitled, according to law, to receive a patent." This language, considered alone, could be read to cover only those cases in which the court, at the conclusion of the judicial proceedings, can direct that a patent be issued—*i. e.*, where no other major issue remains for consideration in the Patent Office. Some support for this construction may be derived from a comparison of Rev. Stat. 4915 with the language of Rev. Stat. 4911 governing the appeal to the Court of Customs and Patent Appeals.

While the two sections provide in substantially identical language for review of the decision of the board of interference examiners, Rev. Stat. 4915 is otherwise confined to situations in which "a patent on application is refused,"⁴ whereas Rev.

⁴ Compliance with this requirement is in no way hampered by the fact that the petitioner here seeks the allowance of claims in a reissue application (a patent already having been granted for claims in the Coons original application). Re-

Stat. 4911 is available to "any applicant" who "is dissatisfied with the decision of the board of appeals." Rev. Stat. 4915 also speaks of an adjudication that the applicant is entitled to a patent, whereas when there is an appeal to the Court of Customs and Patent Appeals under Rev. Stat. 4911, the decision of the court "shall govern the further proceedings in the case." Rev. Stat. 4914; see Appendix A, *infra*, pp. 56-57. This language clearly contemplates review of Patent Office proceedings at intermediate stages, with "further proceedings" in the Patent Office to follow the decision of the Court of Customs and Patent Appeals; whereas it may be argued that the cognate provision in Rev. Stat. 4915 that the judicial decision, if in favor of the applicant, "shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise com-

issue of a patent is authorized by Rev. Stat. 4916 (35 U. S. C. § 64) "Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention * * *." See Appendix A, *infra*, pp. 57-59. The examination of the claims in a reissue application (apart from questions arising from the prior pendency of the subject matter, such as delay and estoppel) is the same as if the claims were in an original application. *In Re Briede*, 27 App. D. C. 298, 303-306. And the remedy by bill in equity under Rev. Stat. 4915 has been regarded as equally applicable to reissue applications. Cf. Rev. Stat. 4909; see Appendix A, *infra*, p. 55.

plying with the requirements of law" refers to such procedural matters as the payment of ~~fees~~^{FINAL} fees (Patent Office Rules 164 and 167; see Appendix A, *infra*, pp. 64-67), and not matters of substance, such as establishing priority of invention. See *Cleveland Trust Co. v. Nelson*, 51 F. (2d) 276, 279 (D. Mich.).⁵ In *Butterworth v. Hoe*, 112 U. S. 50, 61, this Court described the Rev. Stat. 4915 suit as "a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in § 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits."⁶

⁵ But cf. *Gandy v. Marble*, 122 U. S. 432, 440, where this Court said that "The decision of the court on a bill in equity becomes, equally with the judgment * * * on a direct appeal under § 4911, the decision of the Patent Office, and is to govern the action of the Commissioner." Cf. also *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517, 521 (C. C. A. 6).

⁶ Whereas a suit in equity under Rev. Stat. 4915 is a *de novo* proceeding in which evidence—documentary and testimonial—may be introduced, an appeal to the Court of Customs and Patent Appeals under Rev. Stat. 4911 is decided solely upon the Patent Office record, which in so-called "ex parte" cases (where the issue is solely between the applicant and the Patent Office) consists only of documentary evidence and affidavits, and cannot include oral testimony. Rev. Stat. 4911; Rule 76 of Patent Office; see Appendix A, *infra*, pp. 55, 59.

However, the statutory language does not demand such an interpretation. And the historical development of Rev. Stat. 4915 leaves no doubt that Congress intended it to be available whenever a substantive ruling by the Patent Office resulted in the denial of a patent in whole or in part, and that this remedy was to be coextensive with that provided by Rev. Stat. 4911, at least where, as here, the subject matter is susceptible of judicial determination by bill in equity. The legislative intention finds room for acceptance in the provision that the Court shall "authorize" the commissioner to issue a patent upon compliance with the "requirements of law" if the decision favors the applicant. This may easily be read as not imposing a mandatory obligation upon the commissioner, and as permitting inquiry into such "requirements" as whether the applicant can establish his prior right to the claims if an interference is declared. Cf. *Philadelphia Storage Battery Co. v. Zenith Radio Corp.*, 117 F. (2d) 642, 645 (C. C. A. 7).

B. LEGISLATIVE HISTORY

There is considerable evidence in the legislative history of Rev. Stat. 4915 to indicate that (1) Rev. Stat. 4915 was intended to cover a case such as that at bar, in which claims copied to provoke an interference were rejected for want of support in the applicant's disclosure, and (2) Rev. Stats. 4911 and 4915 were intended to be coextensive remedies.

(1) The bill in equity under Rev. Stat. 4915 and the appeal to the Court of Customs and Patent Appeals under Rev. Stat. 4911 are now alternative remedies; invocation of one precludes resort to the other. (See Rev. Stats. 4911, 4915).

But prior to 1927, these remedies were successive rather than alternative, and an unsuccessful appeal under Rev. Stat. 4911 was a condition precedent to a bill in equity under Rev. Stat. 4915.

See Appendix A, pp. 48-49, *infra*; *Kirk v. Commissioner of Patents* (1886) C. D. 440 (Sup. Ct.

D. C.); *Fekete v. Robertson*, 17 F. (2d) 335 (App.

D. C.); *Cooper v. Robertson*, 38 F. (2d) 852 (D.

Md.). The jurisdiction over appeals under Rev.

Stat. 4911 now exercised by the Court of Customs

and Patent Appeals was then vested in the United

States Court of Appeals for the District of Co-

lumbia. See Appendix A, pp. 49-50, *infra*. And

while jurisdiction over suits in equity under Rev.

Stat. 4915 was not (and is not) limited to any

particular United States District Court, as a

practical matter a suit against the Commissioner

of Patents would lie only in the District of Co-

lumbia, where he could always be found, unless he

consented to be sued in another district. *Butter-*

worth v. Hill, 114 U. S. 128. Thus, in the usual

case prior to 1927, the Rev. Stat. 4915 suit would

eventually come before the same court of appeals

that had already adversely disposed of the ap-

plicant's appeal under Rev. Stat. 4911. Dissatis-

faction with this situation was a major considera-

tion leading to the 1927 Act, which made the two procedures alternative.

To illustrate the alleged futility of a second appeal to the same court of appeals, reference was made to *Dilg v. Moore*, 34 App. D. C. 106, at the hearings on one of the earlier bills before the House Committee on Patents.⁷ In that case, claims copied from an outstanding patent in order to provoke an interference were rejected by the Patent Office exactly as in the instant case. Following an unsuccessful appeal under Rev. Stat. 4911 to the Court of Appeals for the District of Columbia, the applicant brought a suit in equity under Rev. Stat. 4915 in the Supreme (now the District) Court for the District of Columbia. In affirming a judgment adverse to the applicant, the Court of Appeals stated (34 App. D. C. at 109):

We are unable to discover wherein the position of appellant has been improved since his last appearance in this court. At that time, his right to make these claims was carefully considered, and we find no reason to change or revise the opinion then given.

While the point here at issue was not mentioned, the reference to *Dilg v. Moore* as an example of a ruling reviewable under Rev. Stat. 4915, indicates at least the understanding that such a situation could be made the subject of a suit in equity even

⁷ Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.), pp. 25, 46-52.

though the action was one in which further proceedings would be necessary before any patent could be issued, and no one present at the hearing challenged this tacit assumption. That this assumption must have been fairly general may be gathered from the fact that prior to the 1927 Act (which, as we shall show later, reenacted Rev. Stat. 4915 without modifying its language of coverage, see pp. 22-25, *infra*), the courts had assumed jurisdiction without question under Rev. Stat. 4915 of Patent Office rulings which, if reversed by the court, would not preclude further proceedings in the Patent Office. Thus, in *Gold v. Newton*, 254 Fed. 824 (C. C. A. 2), a decree in favor of the applicant in a Rev. Stat. 4915 suit on the issue of priority was held not to require the Commissioner to issue the patent if he thereafter discovered a new reference anticipating the applicant's claims. And in *Potter v. Dixon*, 19 Fed. Cas. 1145, 1146 (S. D. N. Y.), where it was held that a decree for the applicant, in an appeal from an award of priority by the Patent Office,

* See also Report of the Investigation of the United States Patent Office made by the President's Commission on Economy and Efficiency, December 1942, H. Doc. No. 1110 (62d Cong., 3d Sess.), pp. 207-208.

"There appears to be an idea quite generally accepted in this country that a citizen is entitled to have any question of fact or of law finally decided by the judicial branch of the Government. So far as decisions in patent matters are concerned, the policy of allowing every question decided in the Patent Office to be reviewed in a court, is one that has existed from the beginning of the patent system."

did not require the issuance of a patent if the applicant failed to prevail in a subsequent interference proceeding with a different outstanding patent, the court said that the same effect would be given to the decree "if the proceedings had taken place in a suit at law or in equity."

(2) The evolution of Rev. Stats. 4911 and 4915 in their present form indicate a congressional intention that they should be coextensive in their scope. Rev. Stat. 4915 finds its origin in the Patent Act of 1836,⁹ which gave an applicant, aggrieved by a ruling of the Commissioner of Patents, a right of appeal to a "board of examiners * * * appointed for that purpose by the Secretary of State." Sec. 7 of Act of July 4, 1836 (5 Stat. 119-120. See Appendix A,

⁹ Act of July 4, 1836, 5 Stat. 117 *et seq.*; see Appendix A, *infra*, pp. 40-43. Prior to 1836, no provision was made for judicial review of the grant or denial of patents. Under the first patent statute (Act of April 10, 1790, 1 Stat. 109), entrusting the granting of patents on application to a board consisting of the Secretary of State, the Secretary of War, and the Attorney General, proposals for appeals had been rejected (see 22 Journ. Pat. Off. Soc., pp. 269-270, 358), and there was no review even though the board refused patents for want of novelty or of utility and importance. Sen. Doc. No. 338 (24th Cong., 1st Sess.), p. 2. Under the Patent Act of 1793 (Act of February 21, 1793, 1 Stat. 318), administered by a superintendent of patents under the Secretary of State but subject to revision by the Attorney General, there was little need for judicial review, since the Act, as construed, merely provided for a registration system, under which patents were granted to anyone who fulfilled the formal requirements, without examination into novelty or usefulness. Sen. Doc. No. 338 (24th Cong., 1st Sess.), p. 2.

p. 41, *infra*). Section 16 of the same Act provided in part that:

whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, * * * any such applicant * * * may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, * * * may * * * adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. * * *

This made provision for a bill in equity only where the application was rejected on account of an interference with an outstanding patent. Section 8 of the Act of March 3, 1837 (5 Stat. 191, see Appendix A, p. 43, *infra*) extended this remedy to an applicant "for any addition of a newly-discovered improvement to be made to an existing patent" or for "correction and re-issue" of

a patent. Two years later the remedy by bill in equity was further extended by Section 10 of the Patent Act of 1839

to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of interference with a previously existing patent * * *. [5 Stat. 353; see Appendix A; *infra*, p. 44].¹⁰

The patent laws were revised, consolidated, and amended by the Patent Act of 1870, which

¹⁰ Section 11 of the 1839 Act substituted for the appeal to a "board of examiners" an appeal to the Chief Justice of the District Court of the United States for the District of Columbia, who might "revise" the decisions of the Commissioner of Patents "in a summary way, on the evidence produced before the Commissioner," and his decision upon certification to the Commissioner, was to "govern the further proceedings of the Commissioner in such case." But the "decision of the Judge in any such case" was not to preclude contesting the validity of any patent "in any judicial court" (see Appendix A, pp. 44-46, *infra*).

By the Act of August 30, 1852 (10 Stat. 75. See Appendix A, p. 46, *infra*), the appeal might "also be made to either of the assistant judges of the Circuit Court of the District of Columbia." When, on March 3, 1863, the Circuit Court was replaced by the Supreme Court of the District of Columbia consisting of a Chief Justice and three Associate Justices, the individual justices of the new court succeeded to the jurisdiction to hear appeals from the Patent Office even though the Act creating the court did not mention appeals from the Commissioner of Patents. Act of March 3, 1863 (12 Stat. 762).

provided (Sec. 46) that in *ex parte* cases "every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected" by the Commissioner could appeal to the Supreme Court of the District of Columbia, sitting in banc (thus replacing the earlier appeal to the individual judges; see footnote 10, *supra*, p. 18).¹¹ The court was "to revise the decision appealed from in a summary way, on the evidence produced before the commissioner" and the "certificate of its proceedings and decision," when returned to, and recorded in the Patent Office, was to "govern the further proceedings in the case" (Sec. 50). See Appendix A, *infra*, pp. 46-47.

Section 52 of the 1870 Act provided in part that:

whenever a patent on application is refused, for *any reason whatever*, either by the commissioner or by the supreme court

¹¹ As passed by the House, the bill eliminated the appeal, while retaining the remedy by bill in equity, H. R. No. 1714; Cong. Globe (41st Cong., 2d Sess.), p. 4820, the purpose being to remove defects inherent in the appellate procedure since 1852. Congressman Jenckes, of the House Committee on Patents, in presenting the bill before the House, referred to the "judges sitting separately and each deciding according to his own notions of the scientific part of any case which happened to come up, and, what was equally bad if not worse, according to his own views of the law in each particular case. There was no concert between them, no consultation, no deference to each other's opinions; and this led to different decisions in the same class of cases." Cong. Globe (41st Cong., 2d Sess.), pp. 2679-2683.

of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requisitions of law. [16 Stat. 198; see Appendix A, *infra*, pp. 47-48.], [Italics supplied.]

Contrary to the literal terms of this section permitting a bill in equity following an adverse decision of the Commissioner of Patents, an appeal from the decision of the Commissioner to the Supreme Court of the District of Columbia was required in *ex parte* cases, before an equity suit would lie. *Kirk v. Commissioner of Patents* (1886) C. D. 440 (Sup. Ct. D. C.), and cases cited *supra*, p. 13.

The language of the 1870 Act was substantially the same, insofar as here relevant, as the present Rev. Stat. 4915, except for the phrase "for any reason whatever." Three years later, when Section 52 of the 1870 Act became Section 4915 of

the Revised Statutes of 1873,¹² the phrase "for any reason whatever" (italicized *supra*) was deleted. No express reference to this change is found in the legislative history, but from the announced general purpose of the revision not "to attempt any change whatever in the existing law" except "mere changes of phraseology not affecting the meaning of the law", it would appear that no change in meaning was intended.¹³

¹² At the same time, Sections 48-51 of the 1870 Act providing for appeal from the Patent Office to the Supreme Court of the District of Columbia became Sections 4911-4914 of the Revised Statutes.

¹³ In reporting H. R. No. 1215 (43rd Cong., 1st Sess.), which ultimately became the Revised Statutes of 1873, the spokesman for the Committee on Revision of the Laws stated to the House:

"The committee have decided that in their judgment it was not advisable to attempt any change whatever in the existing law. By the original law of 1866, under which the commissioners were appointed, they were authorized to make changes to some extent, of which liberty they availed themselves—probably not to any greater extent than they were warranted in doing by the law under which they were appointed. But the Committee on Revision of the Laws at the last Congress came to the conclusion that within the limited time that could be allowed for the work in this House, it would be utterly impossible to carry the measure through, if it was understood that it contained new legislation. Therefore the committee, when they employed Mr. Durant to go over this work, directed him, in every case where he found that new legislation had been inserted by the commissioners, to strike out such modifications of the existing law. This, of course, did not refer to mere changes of phraseology not affecting the meaning of the law; but he was directed, wherever the meaning of the law had been changed, to strike out such changes. Mr. Durant has in the main done this.

It is reasonable to believe that the phrase "for any reason whatever"—which was highly significant when it first appeared in the Patent Act of 1839 (extending the remedy by bill in equity beyond the refusal of patents on account of interference with an outstanding patent)—appeared to the revisers as a redundancy when it followed the clause "whenever a patent on application is refused."

Except for the transfer in 1893 of the appellate jurisdiction of the Supreme Court of the District to the newly created United States Court of Appeals for the District of Columbia (Judiciary Act of 1893, 27 Stat. 434, 436; see Appendix A, *infra*, p. 49), and the reinstatement of the appeal in interference cases, which had been abolished in 1870, the provisions for appeal and bill in equity contained in the Revised Statutes continued in effect until 1927. However, at various times, proposals were advanced for reducing the number of appeals both within the Patent Office and to

* * * the work has been presented with such changes and amendments as we find necessary to make that it will be an exact transcript, an exact reflex, of the existing statute law of the United States—that there shall be nothing omitted and nothing changed." 2 Cong. Rec. 646; see also pp. 647-648. Some changes, later made in evening sessions on the floor of the House, have no pertinence here. See 2 Cong. Rec., pp. 829, 849-58, 995-1001, 1027, 1031, 1206, 1215, 1249-54, 1414-17, 1460-62, 1611-20, 1657-62, 1789-95, 1819-1825, 1968-76, 2005-2013, 2251-2255, 2709-14. On the Senate floor, it was noted that the bill included the revision of the patent laws that had "passed Congress already," i. e., in 1870. 2 Cong. Rec. 4285.

the courts. After the 1893-Act, the sequence of appeals from the Examiner in *ex parte* cases was as follows: Board of Examiners-in-Chief; Commissioner of Patents; appeal to Court of Appeals of the District of Columbia; suit in equity in the District Supreme Court; appeal to the Court of Appeals. Thus, as noted earlier (p. 13), an unsuccessful appeal to the Court of Appeals for the District of Columbia under Rev. Stat. 4911 could be followed by a Rev. Stat. 4915 suit in the Supreme Court of the District of Columbia and an appeal therefrom to the same Court of Appeals.

In the hearings on the bills which became the Act of March 2, 1927 (44 Stat. 1335 *et seq.*), proposals were made to Congress to eliminate either the appeal or the bill in equity. Elimination of the appeal was recommended by the Report of Committee on Patent Office Procedure submitted to the Secretary of Commerce, April 15, 1926. A similar recommendation was made by the Patent Section of the American Bar Association and embodied in H. R. 7087 (69th Cong., 1st Sess.). The Commissioner of Patents favored elimination of the bill in equity, but retention of the appeal. Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.) p. 82; Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487 (69th Cong., 2d Sess.) pp. 8, 14; Hearings, Senate Com-

mittee on Patents, on S. 4812 (69th Cong., 2d Sess.) p. 15.

The resulting Act of 1927 eliminated neither remedy, but permitted the applicant "to have the decision of the Patent Office reviewed either by the court of appeals or by filing a bill in equity, but not both." S. Rep. No. 1313 (69th Cong., 2d Sess.) p. 4; H. Rep. No. 1889 (69th Cong., 2d Sess.) pp. 2-3.¹³ No change appears to have been intended in the kind of rulings to which these remedies were to be applicable. Thus the House Report stated (p. 3) that "under the proposed procedure the defeated party has all the rights and remedies that he had under the old procedure, but the appeals are reduced so that there are but three appeals." A major reason for retention of the bill in equity appears to have been the fact that it permitted the applicant to adduce oral testimony, whereas the appeal under Rev. Stat. 4911 was confined to the record before the Patent Office, which in *ex parte* cases under

¹³ Thereafter, the remedy by bill in equity, rarely used prior to 1927, was resorted to with greater frequency. Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.), pp. 17, 71, 73; Federico, *Evolution of Patent Office Appeals* (1940), 22 Journ. Pat. Off. Soc. 920, 940-941. A study of the Patent Office for the last ten years reveals that *ex parte* cases in the Court of Customs and Patent Appeals (which succeeded the Court of Appeals in Rev. Stat. 4911 cases in 1929) declined from 114 in 1934 to 70 in 1944, whereas Rev. Stat. 4915 cases increased from 24 in 1934 to 57 in 1944 (71 in 1943). See Appendix B, p. 66, *infra*.

the Rules of the Patent Office could not (and cannot now) include oral testimony.¹⁴ The Act of March 2, 1929 (45 Stat. 1475; see Appendix A, *infra*, pp. 52-53) transferring to the Court of Customs and Patent Appeals jurisdiction over appeals from the Patent Office, had no effect upon the scope of Rev. Stats. 4911 and 4915, for the only purpose of the Act was to reduce the burden of work on the Court of Appeals,¹⁵ and it expressly disclaimed any intention to affect "in any way the jurisdiction of the Court of Appeals of the District of Columbia in equity cases." Cf. *Sinko Tool & Manufacturing Co. v. Automatic Devices Corp.*, 136 F. (2d) 186 (C. C. A. 2).¹⁶

The foregoing materials show, we believe, that Congress intended Rev. Stat. 4915 and Rev. Stat. 4911 to be coextensive. Since 1829, when the remedy by bill in equity was extended to the

¹⁴ Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.), pp. 21-22; Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487 (69th Cong., 2d Sess.), p. 11; Hearings, Senate Committee on Patents, on S. 4812 (69th Cong., 2d Sess.), p. 15.

¹⁵ Hearings, House Committee on the Judiciary, on H. R. 6687 (70th Cong., 1st Sess.) *passim*; cf. Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487 (69th Cong., 2d Sess.), p. 31; Hearings, House Committee on Patents on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.), p. 79.

¹⁶ The Act of August 5, 1939 (53 Stat. 1212) modified Rev. Stats. 4911 and 4915 only insofar as necessary to conform their wording to the provisions reducing the number of appeals within the Patent Office in interference cases. See Appendix A, *infra*, pp. 53-54.

refusal of a patent "for any reason whatever," the chief difference between the two remedies (other than the kind of tribunals involved) has been the summary review provided by the appeal, on the record before the Patent Office, as against the trial *de novo* in the equity suit, where new evidence may be introduced and oral testimony taken; but their coverage was seemingly the same, since they were successive remedies. Both in 1870 and 1927 when Congress reexamined and re-enacted these remedies, the emphasis was upon whether one or the other should be eliminated. There is absent any suggestion that Rev. Stat. 4915 would have a narrower application than Rev. Stat. 4911, or that the former would apply only to those cases where the court could direct that a patent should issue without further proceedings in the Patent Office. As already noted, the contrary inference is to be gathered from the reference in the 1927 hearings to the case of *Dilig v. Moore*, in which the Court of Appeals reviewed in a Rev. Stat. 4915 suit the right of an applicant to make a claim copied from an outstanding patent. See also *Gandy v. Marble*, 122 U. S. 432, 440, in which this Court said that "The decision of the court on a bill in equity becomes, equally with the judgment * * * on a direct appeal under § 4911, the decision of the Patent Office, and is to govern the action of the Commissioner." Cf. *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517, 521.

C. JUDICIAL PRACTICE

1. While the decision below appears to be the first in which the question has been raised whether Rev. Stat. 4915 confers jurisdiction in the situation here involved, there are a number of earlier cases in which the court below and other Federal courts exercised jurisdiction without question in the identical circumstances. In the following cases, suits in equity under Rev. Stat. 4915 were heard and determined to review the rejection by the Patent Office of claims which the record showed had been copied from an outstanding patent in order to provoke an interference, and which were disallowed in the Patent Office for want of support in the applicant's disclosure: *Dilg v. Moore*, 34 App. D. C. 106 (three claims in a divisional application); *Power Patents Co. v. Coe*, 110 F. (2d) 550 (App. D. C.) (eight claims in a divisional application); *Tully v. Robertson*, 19 F. (2d) 954 (D. Md.) (several claims in an original application and a continuation-in-part application); *Monopower Corp. v. Coe*, 33 F. Supp. 934 (D. D. C.) (nine claims in an original application); *Forward Process Co. v. Coe*, 116 F. (2d) 946 (App. D. C.) (one claim in an original application). In *E. I. Du Pont De Nemours & Co. v. Coe*, 89 F. (2d) 679 (App. D. C.), claims in a reissue application, copied from another pending application in order to provoke an interference, had been rejected by

the Patent Office on the ground that the applicant was estopped to assert them under Rule 109 of the Patent Office, (see, Appendix A, p. 62, *infra*), and the court below affirmed this action on the merits in a Rev. Stat. 4915 suit. And, in *Booth Fisheries Corp. v. Coe*, 114 F. (2d) 462 (App. D. C.) certiorari denied, 311 U. S. 691, where the court affirmed on the merits a refusal to grant a reissue patent which was to include claims copied from outstanding patents, the record showed that an adjudication favorable to the applicant would have required further proceedings in the Patent Office.

In other cases, the courts have exercised without question jurisdiction to review other kinds of rulings by the Patent Office, even though the record before the court disclosed that further proceedings in the Patent Office would be necessary following an adjudication favorable to the applicant. Thus, in *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, and *American Cyanamid Co. v. Coe*, 106 F. (2d) 851, the court below reversed a ruling by the Patent Office (which the District Court had affirmed) disallowing certain claims of an original application on which an interference was sought, on grounds of estoppel under Rule 109 of the Patent Office. On the remand to the Patent Office, the issue of priority was of course open for consideration, and in fact the desired interference was declared in the *Cellucotton* case.

Patented File, Thompson Patent No. 2,134,459."

Even where the controversy in the Patent Office merely involves a requirement of division, the court below has accepted jurisdiction under Rev. Stat. 4915. In *Pitman v. Coe*, 68 F. (2d) 412 (App. D. C.), a Patent Office ruling required division of a renewal application into two applications, and in a Rev. Stat. 4915 suit to test that ruling, the court's jurisdiction was questioned, the contention being made that the remedy lay in the Court of Customs and Patent Appeals. Although the ruling assailed merely required two applications instead of one, the court below held that there was jurisdiction, saying (at p. 414): "There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive or complete than that allowed by bill in equity. * * * The difference between the two is a difference of procedure rather than a difference of interest."

Where the record does not show that further proceedings will be required in the Patent Office, e. g., where the sole question presented is one of invention, the court below has not hesitated to entertain suits against the Commissioner under

¹⁷ The doctrine of the *Cellucotton* case was applied by the District Court of the District of Columbia in *Youngstown Sheet and Tube Co. v. Coe*, Civil Action No. 5460, decided April 8, 1941 (unreported) and thereafter an interference proceeding was instituted in the Patent Office on the same claims in issue in the Rev. Stat. 4915 suit. Patented Files, Adams Patents, Nos. 2,335,894, and 2,335,895.

Rev. Stat. 4915. *American Steel and Wire Co. v. Coe*, 105 F. (2d) 17 (App. D. C.); *Abercrombie v. Coe*, 119 F. (2d) 458 (App. D. C.); *General Motors Corp. v. Coe*, 120 F. (2d) 736 (App. D. C.); *Hydraulic Press Corp. v. Coe*, 124 F. (2d) 521 (App. D. C.); *Minnesota Mining & Manufacturing Co. v. Coe*, 125 F. (2d) 198 (App. D. C.) This is true, even though the court's favorable ruling on patentability may be followed by interference proceedings in the Patent Office which deprive the applicant of a patent, because of want of priority, on the very claims which the court had allowed. *Radtke Patents Corp. v. Coe*, 122 F. (2d) 937 (App. D. C.), certiorari denied, *sub nom. American Tri-Ergon Corp. v. Radtke Patents Corp.*, 314 U. S. 695; *Poulsen v. McDowell*, 142 F. (2d) 267 (C. C. P. A.). And conversely, where an applicant has been successful in a Rev. Stat. 4915 proceeding on the issue of priority, there has been no challenge by the courts to the right of the Patent Office subsequently to disallow the same claims for want of invention over a newly discovered reference. *Gold v. Newton*, 254 Fed. 824 (C. C. A. 2). Cf. *Potter v. Dixon*, 19 Fed. Cas. 1145, (C. C. S. D. N. Y.). Such has been the consistent administrative practice in the Patent Office. Following an adjudication in favor of an applicant in a suit under Rev. Stat. 4915, based either upon patentability or priority, the Patent Office has felt free to disallow the claims in issue on account of a newly discovered

reference, or of want of priority over newly discovered patents or applications. See letter from Commissioner of Patents, Appendix C, *infra*, p. 67.

The court below relied upon *Hill v. Wooster*, 132 U. S. 693, to support the proposition that "A proceeding under Section 4915 R. S. cannot select a single issue which affects plaintiff's right to a patent, without determining all the other issues on which that right depends." But, in that case, involving a contest over priority where the Patent Office had failed to inquire into the question of invention, this Court merely held that it would refuse an adjudication in favor of the applicant, unless the applicant showed to the Court that the alleged invention for which a patent was sought in fact constituted an invention. The case did not purport to decide what Patent Office rulings were reviewable under Rev. Stat. 4915. Similarly, *Radtke Patents Corporation v. Coe*, 122 F. (2d) 937 (App. D. C.), certiorari denied, 314 U. S. 695, upon which the court below also relied, merely held that upon review of a Patent Office ruling on priority, the court would also inquire into the question of invention.

2. The question of jurisdiction under Rev. Stat. 4915 has been raised in a number of situations involving procedural rulings. In most of them jurisdiction has been denied, but the Court of Customs and Patent Appeals has likewise de-

clined jurisdiction under Rev. Stat. 4911 in such situations. And a distinction has in several cases been expressly noted between a procedural ruling and one which denies a patent "on the merits."

In *Butterworth v. Hoe*, 112 U. S. 50, 68, holding that the Secretary of the Interior lacked authority to reverse a decision by the Commissioner of Patents to issue a patent, this Court stated: "The remedy by bill in equity under § 4915 is not appropriate, because it applies only when the Commissioner decides to reject an application for a patent, on the ground that the applicant is not, on its merits, entitled to it." Thus, in *Shoemaker v. Robertson*, 54 F. (2d) 456 (App. D. C.), the refusal to consider an application lacking the required number of signatures was held unreviewable under Rev. Stat. 4915; on the authority of the above-cited dictum in *Butterworth v. Hoe*. A like reason has been advanced for denying review of the refusal to consider claims tendered in an unresponsive amendment to an application (*Chessin v. Robertson*, 63 F. (2) 267 (App. D. C.) certiorari denied, 289 U. S. 725), or claims first advanced in an untimely petition for reconsideration of the rejection of other claims (*Cherry-Burrell Corp. v. Coe*, 143 F. (2d) 372 (App. D. C.)). The bill in equity under Rev. Stat. 4915 has been held unavailable to challenge the denial of a petition to revive an abandoned application, the courts taking the view that the appellant "has no pending application in the Pat-

ent Office" (*Chessin v. Robertson*, 63 F. (2d) 267 (App. D. C.)) or that the matter is "entirely within the discretion" of the Commissioner, and is not "equivalent to the refusal to grant a patent" as required by Rev. Stat. 4915 (*Cregier v. Coe*, 67 F. (2d) 692 (App. D. C.) certiorari denied, 291 U. S. 683). Jurisdiction under Rev. Stat. 4915 has also been held lacking to review the granting of a motion to dissolve an interference or the denial of a motion to add counts to an interference under Rule 109 of the Rules of Practice in the Patent Office, such rulings being characterized as "interlocutory" and "not the same as a refusal of a patent" (*Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. (2d) 847 (C. C. A. 3); *American Cable Co. v. John A. Roebling's Sons Co.*, 65 F. (2d) 801 (App. D. C.)).¹⁸

Many of the rulings held unreviewable under Rev. Stat. 4915 have likewise been held unreviewable by the Court of Customs and Patent Appeals under Rev. Stat. 4911. *Spatafora v. Zaiger*, 69 F. (2d) 118 (C. C. P. A.) (ruling amounting to dissolution of an interference); *Carlin v. Goldberg*, 45 App. D. C. 540 (granting of motion to dissolve interference); *In Re Stern*, 40 F. (2d) 1000 (C. C. P. A.) (refusal to consider claims presented after decision by Board of Appeals on the merits of other claims); *In Re Slate*, 108 F. (2d) 268 (C. C. P. A.) (same); *In Re Marrogenis*, 57 F. (2d) 361 (C. C. P. A.) (refusal to revive an

¹⁸ Cf. *Pitman v. Coe*, discussed *supra*, p. 29.

abandoned application). It is doubtful that review by mandamus would be available in these cases.¹⁹

D. THE NATURE OF THE PATENT OFFICE RULING IN THIS CASE

Apparently relying upon the cases refusing to review the dissolution of interference proceedings, the court below characterized the rejection of the copied claims in the case at bar, as a "preliminary step" or an "intermediate proceeding," inappropriate for the intervention of equity. This view, we believe disregards the final character of the ruling in question. Unlike the dissolution of an interference proceeding or the refusal to expand it, which allows the applicant to continue the

¹⁹ Cf. *Steinmetz v. Allen*, 192 U. S. 543 (permitting mandamus to review requirement of division under rule prohibiting joinder of process and structure claims in the same application); *Coe v. United States ex rel. Remington Rand Inc.*, 84 F. (2d) 240 (App. D. C. 1936) (allowing mandamus to compel consideration of an amendment offered in part to meet the objections noted by the Primary Examiner in the first rejection of certain claims in an application); *Minnesota Mining & Manufacturing Co. v. Coe*, 143 F. (2d) 12 (App. D. C.) (refusing mandamus to compel Commissioner to enter an amendment to an application which had been finally rejected by the Primary Examiner, including claims copied from another application to provoke an interference); *Scenson v. Coe*, 101 F. (2d) 684 (App. D. C.) (refusing mandamus to compel Commissioner to hold public use proceedings); *United States ex rel. American Gas Accumulator Co. v. Coe*, 84 F. (2d) 398 (App. D. C.) (refusing mandamus to compel Commissioner to enter judgment in conformity with ruling of interference examiner on motion to dissolve interference).

prosecution of his claims *ex parte* and permits a later Rev. Stat. 4915 suit in the event that the claims are finally rejected by the Patent Office (cf. *American Cable Co. v. John A. Roebling's Sons Co.*, 65 F. (2d) 801 (App. D. C.); *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. (2d) 847 (C. C. A. 3)), the rejection of claims *ex parte* for want of support in the applicant's disclosure definitively eliminates those claims insofar as the administrative processes of the Patent Office are concerned, so that at no later stage in the prosecution of the application will there be an opportunity to test the rejection of the copied claims by a Rev. Stat. 4915 suit.²⁰ Inasmuch as this finally disposes of petitioner's claim, it cannot be regarded as a mere procedural ruling. The condition upon which the court below indicated it would take jurisdiction—i. e., where the ques-

²⁰ Although the alternative procedure under Rev. Stat. 4911 would normally be available, this would not afford the applicant a judicial remedy, since the Court of Customs and Patent Appeals in such cases acts in an administrative capacity on the Patent Office record, and its decision cannot be reviewed in this or any other court. *Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693, 699; *Frasch v. Moore*, 211 U. S. 1; *Butterworth v. Hoe*, 112 U. S. 50. It is well established that a proceeding under Rev. Stat. 4915 is judicial. *Butterworth v. Hoe*, 112 U. S., at 61; *Gandy v. Marble*, 122 U. S. 432; *Hill v. Wooster*, 132 U. S. 693; *Morgan v. Daniels*, 153 U. S. 120; *Victor Talking Machine Company v. Brunswick-Balke-Collender Company*, 273 U. S. 670; *Westinghouse Electric & Mfg. Co. v. De Forest Radio, Telephone & Telegraph Co.*, 278 U. S. 562; *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517 (C. C. A. 6); *Cleveland Trust Co. v. Nelson*, 51 F. (2d) 276 (D. Mich.).

tion of priority as well as invention could be decided on the record—can never be met here, since with the rejection of the instant claims petitioner is denied any opportunity to make a record in the Patent Office as to his priority with respect to the like claims in the interference. Thus, the ruling by the Patent Office is just as final as an order by a trial court sustaining a demurrer to a complaint or dismissing a complaint for want of jurisdiction. That the tribunal, if reversed, may upon further consideration of the case, again decide against the complainant on another ground does not detract from the finality of the earlier ruling.

The fact that the Patent Office did not refuse the entire reissue application (having allowed sixteen claims therein) is likewise no bar to the applicability of Rev. Stat. 4915. That provision authorizes the court to adjudicate that the applicant is entitled to receive a patent for his invention “as specified in his claim *or for any part thereof*” (italics supplied)—an indication that the controversy presented may be the validity of only a part of the subject matter of the patent applied for. Moreover, the legislative materials show that the italicized words now refer to one or more claims of an application. As noted earlier, (pp. 16-17), the words “as specified in his claim, or for any part thereof” originated in Section 16 of the Patent Act of 1836. Under the practice then pre-

vailing, there was only one claiming paragraph, sometimes called the "claim" or the "claiming part," and when more than one claim was made in an application, they were included in the claim paragraph separated only by a phrase such as "I also claim." Thereafter, the current practice evolved of inserting separate claims in separately numbered paragraphs. See Lutz, *Evolution of the Claims of United States Patents*, 20 Journ. Pat. Off. Soc., 457, 469. Hence "any part" of an applicant's "claim" would cover what is now referred to as a "claim." Furthermore, unless the final rejection of any claim is a refusal of a "patent" under Rev. Stat. 4915, the remedy by bill in equity would not be available even if all but the least important claim in an application were rejected—an intention not to be imputed to Congress.²¹

While the rejected claims here involved were copied from another patent, that fact should not affect the jurisdictional question in this case. The copying by an applicant of another's claims thought to fall within the disclosure of the applicant is the approved method of crystallizing the

²¹ As we have developed more fully (*supra*, pp. 16-26), the suit in equity under Rev. Stat. 4915 and the appeal to the Court of Customs and Patent Appeals under Rev. Stat. 4911 were intended to be coextensive, and the latter plainly permits review of a decision of the Patent Office rejecting "any of the claims" in an application (Rev. Stat. 4909, 4911; see Appendix A, *infra*, pp. 55-56).

issue of relative priority in time, for substantial identity of competing claims is an essential to the administrative consideration of priority. Rules 93 and 94 of Patent Office; Rev. Stat. 4904; see Appendix A, *infra*, pp. 55, 59-62.

The court below considered this method of provoking interference proceedings to be "artificial" and subject to criticism (R. 146). Whether or not such criticism is deserved, it does not appear to have any bearing on the reviewability under Rev. Stat. 4915 of the rejection of copied claims. Regardless of the origin of the claims, their inclusion within the issued patent would constitute a valuable right by placing the petitioner in the position to assert a *prima facie* title to the subject matter. Conversely, denial of the claim limits the scope of the patent to that extent, and in a subsequent infringement suit, the patent will be treated as inoperative with respect to the subject matter covered by the rejected claims. Walker, *Patents* (Deller's Ed., 1937) p. 1366. If the allowed claims covered the same subject matter as the rejected claims, the rejection would merely deprive petitioner of a decision by the Patent Office on the priority issue, but nothing in the record shows that this is the case here.

CONCLUSION

For the foregoing reasons, we believe that the judgment below should be reversed, and the cause

remanded for consideration of petitioner's case
on the merits. *

✓ CHARLES FAHY,
✓ *Solicitor General.*

FRANCIS M. SHEA,
Assistant Attorney General.

✓ DAVID L. KREEGER,

ROBERT L. STERN,

Special Assistants to the Attorney General.

✓ JOSEPH B. GOLDMAN,

✓ JOSEPH Y. HOUGHTON,

Attorneys.

FEBRUARY 1945

APPENDIX A

STATUTES AND REGULATIONS

I. STATUTES

1. The Act of July 4, 1836 (5 Stat. 117, 119-120, 123-124) provided, in part, as follows:

SEC. 7. * * * That, on the filing of any such application, description, and specification, and the payment of the duty herein-after provided, the Commissioner shall make or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insuffi-

cient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the Treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claim for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion

and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided, however;* That before a board shall be instituted in any such case, the applicant shall pay to the credit of the Treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SEC. 16. * * * That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of

examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided, however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

2. The Act of March 3, 1837 (5-Stat. 191, 193) provided, in part, as follows:

SEC. 8. * * * That, whenever application shall be made to the Commissioner for any addition of a newly-discovered improve-

ment to be made to an existing patent; or whenever a patent shall be returned for correction and re-issue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the Commissioner shall not add any such improvement to the patent in the one case, nor grant the re-issue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim in accordance with the decision of the Commissioner; and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy and be entitled to the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents.

3. The Act of March 3, 1839 (5 Stat. 353, 354-355) provided, in part, as follows:

SEC. 10. * * * That the provisions of the sixteenth section of the before recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner; as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

SEC. 11. * * * That in all cases where an appeal is now allowed by law from the deci-

sion of the Commissioner of Patents to a board of examiners provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the chief justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said chief justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office, may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case, is prayed for. And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of

his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case: *Provided, however,* That no opinion or decision of the judge in any such case, shall preclude any person interested in favor or against the validity of any patent which has been or may hereafter, be granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

4. The Act of August 30, 1852 (10 Stat. 75) provided, in part, as follows:

That appeals provided for in the eleventh section of the act entitled An Act in addition to an act to promote the progress of the useful arts, approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the Circuit Court of the District of Columbia, and all the powers, duties, and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges.

5. The Act of July 8, 1870 (16 Stat. 198, 204-206) provided, in part, as follows:

SEC. 46. * * * That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law.

SEC. 47. * * * That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the commissioner in person.

SEC. 48. * * * That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.

SEC. 49. * * * That when an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the patent office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

SEC. 50. * * * That it shall be the duty of said court, on petition, to hear and determine such appeal, and to revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint, notifying the commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. And after hearing the case, the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the patent office, and govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 52. * * * That whenever a patent on application is refused, for any reason

whatever, either by the commissioner or by the supreme court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

6. The Revised Statutes of 1873 (at p. 958) provided, in part, as follows:

SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.

SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings

had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent-Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

7. The Act of February 9, 1893 (27 Stat. 434, 436) provided, in part, as follows:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be, and there is hereby, established in the District of Columbia a court, to be known as the court of appeals of the District of Columbia, which shall consist of one chief justice and two associate justices, who shall be appointed by the President, by and with the advice and consent of the Senate, and shall hold office during good behavior.

SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the supreme court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall

hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals.

8. The Act of March 2, 1927 (44 Stat. 1335, 1336-1337) provided, in part, as follows:

SEC. 7. That section 9 of the Act of February 9, 1893, entitled "An Act to establish a court of appeals for the District of Columbia, and for other purposes" (Twenty-seventh Statutes at Large, page 434), be, and the same is hereby, repealed.

SEC. 8. That section 4911 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default

of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said board of appeals shall be withheld pending the final determination of said proceeding under said section 4915."

SEC. 9. That section 4912 of the Revised Statutes of the United States be amended by striking out the words "Supreme Court of the District of Columbia" and substituting therefor the words "Court of Appeals of the District of Columbia."

* * * * *

SEC. 11. That section 4915 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 4915. Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner

to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit."

9. The Act of March 2, 1929 (45 Stat. 1475, 1476) provides, in part, as follows:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the title of the United States Court of Customs Appeals, created by the Act approved August 5, 1909, is hereby changed to the United States Court of Customs and Patent Appeals.

SEC. 2 (a) The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

(b) Sections 4911 (Forty-fourth Statutes, page 1336), 4912 (section 60, title 35, United States Code), and 4915 (section 63, title 35, United States Code) of the Revised Statutes, as amended, and section 9 of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February 20, 1905 (United States Code, title 15, section 89), are amended by striking out the words "Court of Appeals of the District of Columbia" wherever they occur therein and inserting in lieu thereof the words "United States Court of Customs and Patent Appeals" in each instance.

* * * * *

(d) Nothing contained in this Act shall be construed as affecting in any way the jurisdiction of the Court of Appeals of the District of Columbia in equity cases.

10. The Act of August 5, 1939 (53 Stat. 1212-1213) provides, in part, as follows:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 4904 of the Revised Statutes (U. S. C., title 35, sec. 52) be amended to read as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue

a patent to the party who is adjudged the prior inventor."

SEC. 2. That section 4909 of the Revised Statutes (U. S. C., title 35, sec. 57) be amended to read as follows:

"Every applicant for a patent or for the reissue of a patent; any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal."

SEC. 3. That section 4911 of the Revised Statutes (U. S. C., title 35, sec. 59a) be amended by changing the words "Board of Appeals" in the second sentence to read "board of interference examiners", and by canceling the last sentence of said section.

SEC. 4. That section 4915 of the Revised Statutes (U. S. C., title 35, sec. 63) be amended, by changing the first sentence thereof to read:

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear."

11. Sections 4904, 4909, 4911, 4912, 4914-4916 R. S., as amended (35 U. S. C. 52 *et seq.*), provide as follows:

SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.

SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. [U. S. C., title 35, sec. 63.] If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes [U. S. C., title 35, sec. 60].

file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

SEC. 4912. When an appeal is taken to the United States Court of Customs and Patent Appeals, the applicant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of

Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties, the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

SEC. 4916. Whenever any patent is wholly or partly inoperative or invalid, by reason

of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new

matter shall be introduced into the specification, nor in the case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

II. REGULATIONS

The Rules of Practice in the United States Patent Office (Reprint September 1, 1943) provide, in part, as follows:

Rule 76. When an application is rejected on reference to an expired or unexpired domestic patent which shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the office, set forth in an affidavit (when requested) of such employee (rule 66), or when rejected on the ground of public use or sale, or upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or frivolous or injurious to public health or morals, affidavits or depositions supporting or traversing these references or objections may be received, but affidavits will not be received in other cases without special permission of the Commissioner. (See rule 138.)

Rule 93. An interference is a proceeding instituted for the purpose of determining

the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent. In order to ascertain whether any question of priority arises the Commissioner may call upon any junior applicant to state in writing under oath the date and the character of the earliest fact or act, susceptible of proof, which will be relied upon to establish conception of the invention under consideration. The sworn statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than twenty days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

Rule 94. Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and

unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy, in this country, before the filing date of the patentee; and, when required, the applicant shall file an affidavit setting forth facts showing that he completed the invention in controversy, in this country, before the filing date of the patentee.

Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion he cannot make the other claims and state further that the interference will be promptly declared and that the applicant may proceed under rule 109, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application un-

less such amendment is filed within one year from the date on which said patent was granted.

Parties owning applications or patents which contain conflicting claims will be required to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

Rule 109. An applicant involved in an interference may, within a time fixed by the examiner of interferences not less than thirty days after the preliminary statements (referred to in rule 110) of the parties have been received and approved, or if a motion to dissolve the interference has been brought by another party, within thirty days from the filing thereof, on motion duly made as provided by rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties.

Such motion must be accompanied by the proposed amendment, and when in proper form will be set by the examiner of interferences for hearing before the primary examiner. Where a party opposes the admission of such an amendment in view of prior patents or publications, full notice of such patents or publications, applying them to the proposed counts, must be given to all parties at least twenty days prior to the date of hearing. On the admission of such amendment and the adoption of the claims by the other parties within a time specified the primary examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include the said claims. New pre-

liminary statements will be received as to the added claims, but motions for dissolution with regard thereto will not be considered where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference without the consent of the Commissioner, except as provided herein and in rule 106.

Any party to an interference may bring a motion to put in interference any claims already in his application or patent which should be made the basis of interference between himself and any of the other parties. Any party to an interference may bring a motion to add or substitute any other application owned by him, as to the existing issue, or to include an application or a patent owned by him, as to claims which should be made the basis of interference between himself and any of the other parties. Such motions are subject to the same conditions and the procedure in connection therewith is the same, so far as applicable, as hereinabove set forth for motions to amend.

Rule 149. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within 40 days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing; *Provided, however,* That if a petition for rehearing or reconsideration is filed within 20 calendar days after said decision, the notice

of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing on reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal.

If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C., title 35, sec. 62).

If a defeated party to an interference proceeding appeals to the U. S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 4915 R. S., certified copies of the foregoing papers will be transmitted to the U. S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 154 (b). [See rule 153 (a).]

From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals.

Rule 164. If, on examination, it shall appear that the applicant is justly entitled to a patent under the law, a notice of allowance will be sent him, his attorney or his agent, calling for the payment of the final

fee within six months from the date of such notice of allowance, upon the receipt of which within the time fixed by law the patent will be prepared for issue. (See rules 167, 194.)

Rule 167. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant, his attorney or his agent; and if the final fee be not paid within that period the patent shall be withheld. (See rule 175.) In the absence of request to suspend issue the patent will issue in regular course. The issue closes weekly on Thursday, and the patents bear date as of the fourth Tuesday thereafter.

A patent will not be antedated.

APPENDIX B

Comparison of number of *ex parte* suits under
Rev. Stats. 4911 and 4915 in the last decade.

Year (July 1-June 30):	Court of Customs and Patent Appeals, Cases	District Court Cases
1934-1935	144	24
1935-1936	82	44
1936-1937	87	37
1937-1938	73	72
1938-1939	74	43
1939-1940	78	50
1940-1941	87	53
1941-1942	61	43
1942-1943	71	71
1943-1944	70	57

APPENDIX C

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

WASHINGTON, *February 16, 1945.*

Hon. CHARLES FAHY,
Solicitor General,
Department of Justice,
Washington, D. C.

MY DEAR MR. SOLICITOR GENERAL.—This is in reply to your recent inquiry concerning the practice of this Office with respect to its further action on a patent application following an adjudication favorable to the applicant in a proceeding under Rev. Stat. 4915.

As you no doubt know, when claims are finally rejected by the examiner and his action is affirmed by the Board of Appeals, the grounds then stated for such rejection, as well as any other grounds in support thereof, may be set up by this Office in answer to a subsequent suit by the applicant under Rev. Stat. 4915. If the adjudication by the court is favorable to the applicant, it is the practice of this Office to treat that judgment as conclusive with respect to any ground of rejection urged before the court in defense of the refusal to allow the claims in issue. In the usual case, following such adjudication, the application is allowed and, upon payment of the prescribed

fee, the patent is issued. However in rare instances where, after termination of the suit, a new reference is discovered which shows lack of patentability of the claims for a reason not considered by the court, this Office considers itself under a duty to reject the claims on the newly discovered ground, and to refuse a patent on those claims unless the applicant can overcome the new ground of rejection. Similarly, if another applicant or a patentee is claiming substantially the same subject matter as that held patentable in the Rev. Stat. 4915 suit and a question of priority arises, interference proceedings may be necessary under Rev. Stat. 4904 to determine which of the adverse claimants is the first inventor. Examples of this practice are reflected in *Radtke Patents Corp. v. Coe*, 122 F. (2d) 937 (App. D. C.), certiorari denied, 314 U. S. 695, and *Poulsen v. McDowell*, 142 F. (2d) 267 (C. C. P. A.).

The foregoing is believed to have been the consistent practice of this Office for many years.

Sincerely yours,

CONWAY P. COE,
Commissioner.

